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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85751546
Applicant	Neato Robotics, Inc.
Applied for Mark	NEATO BOTVAC
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Date	05/17/2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matters[1] of:

U.S. Application Serial No.	85/757,665
For the Mark:	BOTVAC
U.S. Application Serial No.	85/757,674
For the Mark:	BOTVAC
U.S. Application Serial No.	85/751,529
For the Mark:	NEATO BOTVAC
U.S. Application Serial No.	85/751,546
For the Mark:	NEATO BOTVAC

NEATO ROBOTICS, INC, *Applicant/Appellant*.	*Ex Parte* Appeal No. 85751546

APPLICANT/APPELLANT'S REPLY *EX PARTE* APPEAL BRIEF

[1] On March 27, 2015, the Board consolidated Applicant's four (4) pending *ex parte* appeals regarding the BOTVAC mark, namely, proceeding nos.: (i) 85757665; (ii) 85757674; (iii) 85751529; and (iv) 85751546. The Board's March 27 Order stated: "[i]f the appeals are presented on the same brief, the brief should bear the serial number of each consolidate[d] application, and a copy of the brief should be submitted for each application." Pursuant to the March 27 Order, Applicant submits the instant consolidated reply brief, and will file a separate copy of same for each application.

I. Index of Citations

II. Preliminary Statement

The Examining Attorney fails to carry its burden of proving that Applicant's applied-for BOTVAC mark is merely descriptive of Applicant's goods. As discussed in Applicant's opening brief, to carry its burden, the Examining Attorney must present evidence regarding consumer understanding of "botvac" (which would establish that consumers already uniquely associate BOTVAC with the applied-for goods). However, the Examining Attorney, once again, presents evidence regarding alleged consumer understanding of terms such as "bot," "robot," and "robotics," none of which Applicant applied to register. Accordingly, the Examining Attorney's disclaimer requirement should be reversed.

III. Argument

A. The Examining Attorney Failed to Carry its Burden of Establishing the BOTVAC Mark is Merely Descriptive of Applicant's Goods

As discussed in Applicant's opening brief, there is a four-step analysis in determining whether the Examining Attorney carried its "burden of showing that [BOTVAC] is merely descriptive of the identified goods [in the '546 Application]." *In re Tofasco of America, Inc.*, 2013 WL 5407234, *1 (TTAB, 2013). For purposes of brevity, only the fourth factor need be addressed to demonstrate the Examining Attorney failed to carry its burden.

Under the fourth step, the Examining Attorney had to prove that a relevant consumer encountering the BOTVAC mark in the marketplace would *immediately* recognize and understand it as describing the nature, quality, or characteristics of Applicant's goods and services. *See In re Shutts*, 217 U.S.P.Q. 363, 364 (T.T.A.B. 1983) (mark is merely descriptive when it "readily and immediately evoke[s] an impression and understanding" of the goods identified by the mark.").

To prove this, the Examining Attorney had to proffer evidence regarding consumer understanding and recognition of Applicant's applied-for mark: BOTVAC. *See In re Future Ads LLC*, 103 U.S.P.Q.2d 1571 (TTAB, 2012) (the Board reversing the Examining Attorney's disclaimer requirement because, *inter alia*, the "examining attorney did not submit any evidence with her two Office actions showing the term 'arcadeweb' or 'arcade web' used or referenced in connection with services of the type identified in applicant's application […]."). However, the Examining Attorney proffered evidence regarding alleged consumer understanding of terms that Applicant did <u>not</u> apply to register. For example, the Examining Attorney states:

> "The trademark examining attorney refers to the excerpted materials from the Google search engine in which references to "robot" and to 'bot,' used in connection with vacuum cleaners and other robotic appliances appeared in several stories. This evidence demonstrates that consumers are familiar with the terms 'bot' and 'robots' used in connection with robot vacuum cleaners and other goods featuring robotic technology. See attachments and excerpts below, especially those referencing applicant, Neato Robotics or 'Neato.'" Examiner's Brief at 8.

To take another example, the Examining Attorney states:

> "[T[he dictionary evidence and Internet evidence, made of record, by the examining attorney, clearly demonstrates that the designation 'bot' is understood to mean 'robot' when used in connection with robotic appliances, including, robot vacuum cleaners. More importantly, references to the wording 'bots' in online advertising material and news articles, related to applicant's robot vacuum cleaners, support the conclusion that the <u>mark in its entirety</u> is merely descriptive." (emphasis supplied). Examiner's Brief at 11.

In short, the Examining Attorney's failure to present evidence regarding consumer understanding of BOTVAC renders it impossible to determine whether consumers *immediately* understand BOTVAC to be merely descriptive of Applicant's goods. Accordingly, the Examining Attorney's disclaimer requirement should be reversed.

B. The Examining Attorney Failed to Rebut Applicant's Arguments That BOTVAC Can be Considered Either a Fanciful, Arbitrary, or Suggestive Trademark

As discussed *infra*, the Examining Attorney also failed to rebut Applicant's arguments that the coined term BOTVAC can be considered either a: (i) fanciful; (ii) arbitrary; or (iii) suggestive trademark.

1. BOTVAC Can be Considered a Fanciful Trademark

The Examining Attorney failed to rebut Applicant's argument that the coined term BOTVAC can be considered a fanciful trademark. The Examining Attorney admits it is "true" that Applicant's coined term "botvac" does not appear in the dictionary, *i.e.*, that "botvac" is unknown in the language. *See* Examiner's Brief at 12. Notably, as stated in Applicant's opening brief, fanciful trademarks include marks that are unknown in the language. Nonetheless, the Examining Attorney states the:

> "fact that a term is not found in a dictionary is not controlling on the question of registrability if the evidence of record shows that the term has a well understood and recognized meaning […] [t]he evidence made of record demonstrates that BOTVAC used in connection with the applied-for goods is not fanciful." Examiner's Brief at 12-3.

Not to put too fine of a point on it, but there is *no* record evidence regarding consumer understanding and recognition of Applicant's applied-for mark: BOTVAC. Rather, as discussed *supra*, the Examining Attorney's evidence concerns alleged consumer understanding of terms that Applicant did *not* apply to register. Accordingly, the Examining Attorney failed to rebut Applicant's argument that BOTVAC can be considered a fanciful trademark.

2. BOTVAC Can be Considered an Arbitrary Trademark

The Examining Attorney also failed to rebut Applicant's argument that the term BOTVAC, as applied to Applicant's goods, can be considered an arbitrary trademark. As stated in Applicant's opening brief, arbitrary trademarks "comprise words that are in common linguistic use but, when used to identify particular goods or services, do not suggest or describe a significant ingredient, quality, or characteristic of the goods or services." TMEP § 1209.01(a).

Here, the Examining Attorney states:

> "When the mark BOTVAC is used in the context of applicant's goods, specifically, robotic vacuum cleaners, it seems clear that the applied for mark is not arbitrary. There is nothing incongruous in the combination BOTVAC when the evidence of record establishes that among other things the wording 'bot' is commonly used in reference to 'robot' and 'robotic and 'vac' is informal for vacuum cleaner." Examiner's Brief at 13.

However, the Examining Attorney's argument presupposes the noun "bot" has a fixed understanding; it does not. As discussed in Applicant's opening brief, "bot" has numerous understandings and meanings, including: (i) "the larva of a botfly"; (ii) "a device or piece of software that can execute commands, reply to messages, or perform routine tasks, as online search, either automatically or with minimal human intervention (often used in combination): *intelligent infobots; shopping bots that help consumers find the best prices*"; (iii) botanical; (iv) botanist; (iv) botany; and (v) bottle. (emphasis in original).

Accordingly, as discussed in Applicant's opening brief, the combination of "bot" and "vac" does not necessarily result in a term that consumers understand as describing Applicant's goods. Instead, consumers could understand the portmanteaux "botvac" as describing goods or services concerning (i) vacuums and botfly larvae, or (ii) vacuums and Internet-based searches, neither of which describe Applicant's goods. As such, Applicant's use of "botvac" is arbitrary and uncommon. Therefore, BOTVAC can be considered an arbitrary mark.

3. BOTVAC Can be Considered a Suggestive Trademark

The Examining Attorney further failed to rebut Applicant's argument that BOTVAC may can be considered a suggestive trademark when applied to Applicant's goods.

As stated in Applicant's opening brief, if, "when goods or services are encountered under a mark, a multistage reasoning process, or resort to imagination, is required in order to determine the attributes or characteristics of the product or services, the mark is suggestive rather than merely descriptive." *In re David P. Cooper*, 2013 WL 5407254, *2 (TTAB, June 10, 2013).

In attempting to rebut Applicant's argument that BOTVAC is a suggestive trademark, the Examining Attorney states:

> "[T]he examining attorney has analyzed each portion of the compound word mark, BOTVAC to determine whether each portion of the mark 'BOT' and 'VAC' is merely descriptive of the goods and then looked at the compound word mark in its entirety to determine if it is merely descriptive in its entirety. As indicated above, BOTVAC is the equivalent of robot vacuum cleaner, robotic vacuum cleaner and/or vacuum cleaners featuring robotic technology." Examiner's Brief at 15-6.

Thus, the Examining Attorney reasons that a "multistage reasoning process [is not necessary] to determine the attributes indicated by the mark" BOTVAC. Examiner's Brief at 15. However, when analyzing "each portion of the compound word mark, BOTVAC," the Examining Attorney, once again, ignores the fact that "bot" has numerous meanings and understandings. As a result, consumers must momentarily pause, work through these numerous meanings and understandings of BOTVAC, and then take a mental leap in order to correctly determine the nature and characteristics of Applicant's products.

Furthermore, as stated in Applicant's opening brief, if the Board has any doubt regarding whether BOTVAC is a suggestive or descriptive trademark as applied to Applicant's goods, such doubt must be resolved in Applicant's favor.

IV. Conclusion

Based on the foregoing, Applicant respectfully requests that the Board: (i) reverse the Examining Attorney's disclaimer requirement, and (ii) Order that the '546 Application be published for opposition.

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Respectfully submitted,

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